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EXAMINER

SMITH, TERRI L

ART UNIT	PAPER NUMBER
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3762

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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/682,281	Applicant(s) PAI ET AL.	
	Examiner Terri L. Smith	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 29 November 2006 with respect to claims 1–11 and 13–17 have been considered but are moot in view of the new ground(s) of rejection.
2. Additionally, Applicant's arguments filed 29 November 2006 have been fully considered but they are not persuasive. The Examiner respectfully disagrees with Applicant's assertion that none of Parravicini disclose structure having a relationship of elements capable of the portions described connect to one another such that their action is dependently only on ventricular motion. Parravicini discloses a membrane means comprise separate pumping chamber acting independently on the left ventricular wall which allows different pumping pressures to be applied to the two ventricles, ... (e.g., column 2, lines 11–19). In that the structure as taught by Parravicini acts independently on the ventricles, it is readily apparent that the structure is capable of dependently performing action only on ventricular motion.

Regarding Applicant's argument against claim 5 rejected under 35 U.S.C. § 112 second paragraph, Examiner contends that the vagueness of the rejection is not related to the two elements as argued by the Applicant. Rather, that it is unclear how these elements are connected to make an apparatus and which means is connected to which heart structure. Consequently, Examiner maintains said claim 5 rejected under 35 U.S.C. § 112 second paragraph as set forth in the Office Action mailed on 29 June 2006.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "SECTION B-B" in Figure 6C as described in the specification. Figure 6C shows "SECTION E-E" instead.

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Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1–10 and 13–17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. In claim 1, the subject matter, which was not described in the original written specification, is the first portion comprising at least one “elongate member” and in response “only” to expansion of the left ventricle (*underline added for clarity*) in combination with the other elements in the claim(s). Applicant’s original written specification does not disclose a first member comprising an “elongate member,” and that the elements in the claim will cause a contraction in response “only” to expansion of the left ventricle. It is noted that Examiner is aware of Applicant’s disclosure on page 13 in paragraph [040] which states in part: “...this statement is intended to serve as antecedent basis for use of such exclusive terminology as “solely,” “only” and the like in connection with the recitation of claim elements, ...” It is further noted that this statement references “any optional element” and not how the elements function in response to the left ventricle which is what is set forth in the presently claimed invention.

In claim 14, the subject matter, which was not described in the original written specification, is an “elongate” transmission member in combination with the other elements in the claim(s). Although Applicant’s original written specification discloses a transmission link, it does not disclose an “elongate” transmission link.

Additionally, in claim 16, the subject matter, which was not described in the original written specification, is a single elongate connector. Although Applicant’s original written specification discloses a connector on page 23 in paragraph [058] line 3, it does not disclose an “elongate” connector.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the Applicant regards as his invention.

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7. Claims 5 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In claim 5, the phrase "first and second means for ..." is vague. It is unclear how these elements are connected to make an apparatus and which means is connected to which heart structure.

8. Claim 11 recites the limitation "the region." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 5–8, 14, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Parravicini, U.S. Patent 4,536,893.

11. Regarding claims 1, 2, 5, 6, 14, 15 and 17, Parravicini discloses a first portion (e.g., FIGS. 3–4, element 1b-shell connected to left ventricle; column 4, lines 47–48) comprising at least one elongate member and an elongate transmission link (e.g., element 6-feed tube), and a second portion connected with a first portion ... (e.g., column 2, lines 11–19; column 4, lines 49–65 where it is the Examiner's position that when it is required to compress the left ventricle as taught by Parravicini, it is inherently as a result of the expansion of said ventricle);

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first and second means for transferring force ... (e.g., where it is the Examiner's position that the first and second portions as described herein before meet the first and second means as set forth in the claim 5 limitation).

12. With respect to claims 2, 7 and 8, Parravicini discloses a second portion partially surround an aorta (claim 2) (e.g., it is the Examiner's position that the second portion of Parravicini as cited herein above, that is positioned about at least a portion of the left ventricle, inherently at least partially surrounds an aorta because the aorta originates in the left ventricle);

a first portion comprises a pair of members attached to portions of a left ventricle (claim 7) (e.g., elements 4b and 1b); first and second portions form a ribbon shape (claim 8) (e.g., element 3-strap).

13. Claims 1, 2, 3, 5–11, 13, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Melvin, U.S. Patent 6,190,408.

14. Regarding claims 1, 2, 5, 6, 7, 11, 14 and 17, Melvin discloses a first portion comprising at least one elongate member (e.g., FIG. 11B, element 92-rigid portion of 90 represents a first portion and the unlabelled chord that connects elements 92 and 96 represent elongate member),

and a second portion connected with a first portion ... (e.g., element 94-connector portion represents a second portion; column 4, lines 60–61);

first and second means for transferring force ... (e.g., where it is the Examiner's position that the first and second portions as described immediately herein before meet the first and second means as set forth in the claim 5 limitation);

accessing a region of a heart and positioning an apparatus about at least a portion of a heart and an aorta in a configuration selected from a bow (e.g., FIG. 11B; column 6, lines 1–5; column 8, lines 55–56 where it is the Examiner’s position that the cited device of Melvin that is positioned about at least a portion of the left ventricle is inherently positioned about a least a portion of the aorta because the aorta originates in the left ventricle);

an elongate transmission link (e.g., FIG. 13, element 86-cord).

15. With respect to claims 3 and 7–10, Melvin discloses first and second portions are tensile members (claim 3) (e.g., column 7, lines 1–3); a first portion comprises a pair of members attached to portions of a left ventricle (claim 7) (e.g., elements 92); first and second portions form a ribbon (claim 8), are in the form of a figure-eight (claim 9) and form of a figure-eight shape in use (claim 10) (e.g., element 90).

16. Regarding claim 13, Melvin disclose first and second portions capable of form of a triple-loop shape in use because the portions do not have any apparent size limitations that would prevent it from being formed in a triple-loop, they are similar in size and shape to Applicant’s claimed invention, and the size of the portions and the triple-loop have not been defined.

Additionally, Melvin discloses at column 7 in lines 6–7 that the member 62, which is included as part of the brace 60 (which is also the brace 90 in FIG. 11B), can be any desired shape, and can vary according to anatomy and the desired application. Consequently, the element of Melvin is capable of form of a triple-loop shape.

17. With respect to claim 16, Melvin discloses only a single elongate connector (e.g., element 96-connector).

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this Final Action is set to expire THREE MONTHS from the mailing date of this Action. In the event a first reply is filed within TWO MONTHS of the mailing date of this Final Action and the Advisory Action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the Advisory Action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the Advisory Action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this Final Action.

19. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terri L. Smith whose telephone number is (571) 272-7146. The Examiner can normally be reached on Monday - Friday between 7:30 a.m. - 4:30 p.m..

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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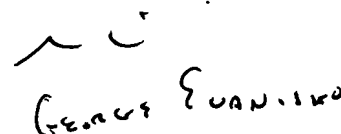
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TLS

November 9, 2007

9 November 2007



Genes E. Evans
Primary
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